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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,068	08/18/2000	John R. Stuelpnagel	A-68364-1/RMS/DCF	6751

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EXAMINER

STRZELECKA, TERESA E

ART UNIT	PAPER NUMBER
1637	

DATE MAILED: 08/13/2002

PL

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/642,068 Teresa E Strzelecka	STUELPNAGEL ET AL. 1637
<b>Examiner</b>	<b>Art Unit</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 10 June 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This Office action is in response to an amendment filed on June 10, 2002.

### ***Response to Arguments***

2. Applicant's arguments filed on June 10, 2002 have been fully considered but they are not persuasive. Applicants argue that the Holmes et al. reference does not anticipate claim 1. Claim 1 teaches generating pools of oligonucleotides by providing a substrate and at least first and second oligonucleotides linked to the substrate by first and second linkers, and cleaving the first and second linkers, releasing the first and second oligonucleotides from the substrate and generating a pool of oligonucleotides. Applicants argue that even though Holmes et al. teach polymers attached to substrate by cleavable linkers and cleavage of the polymers from the substrate for control analysis, they do not teach generating pools of oligonucleotides.

However, Applicants claims generate a pool by cleaving at least two oligonucleotides from the substrate, and Holmes teaches synthesizing polymers (peptides, oligonucleotides, etc.) on the solid substrate, where they are attached by cleavable linkers and cleaving the polymers from the substrate, which are exactly the same steps as the ones of claim 1. In addition, Holmes et al. teach that the oligomers cleaved from the substrate can be used in subsequent assays (col. 12, lines 6-16) (see the previous Office action).

The previous art rejection is maintained.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes (U.S. Patent No. 5,679,773).

Holmes et al. teach compounds (oligonucleotides, peptides, etc.) synthesized on solid supports, which may contain wells, and beads distributed on the surface of the support, from which the synthesized compound may be released upon completion of the synthesis (Abstract; col. 5, lines 64-67; col. 6, lines 26-37; col. 19, lines 58-67; col. 20, lines 1-7; col. 22, lines 11-16). The compounds may be synthesized by photolithography (col. 7, lines 23-40; col. 18, lines 1-67). The synthesized compounds may form a chip or an array (col. 10, lines 15-37).

The oligomers (e.g. oligonucleotides) are attached to the solid support by covalent linkers, which are photochemically or chemically cleavable and the released oligomers are then used in subsequent bioassays (col. 12, lines 6-16; col. 20, lines 7-15). The linker may also contain a reactive group to which a label can be attached, resulting in a labeled oligomer. The label is chromogenic, for example, fluorescent, providing different labels (col. 20, lines 33-67; col. 21, lines 1-67). The labels may also be attached at the end of the synthesis (col. 22, lines 24-25).

#### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (703) 306-5877. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

TS  
August 7, 2002

TS

*Kenneth R. Horlick*  
KENNETH R. HORLICK, PH.D  
PRIMARY EXAMINER

8/8/02